



## New French Decree Modifies Rules to Protect Confidential Documents During Infringement Seizure

### IN SHORT

**Context:** French Decree No. 2018-1126 of 11 December 2018 on the protection of trade secrets, enacted in application of Act No. 2018-670 of 30 July 2018, establishes rules to preserve trade secrets in the context of civil and commercial proceedings and substantially modifies the rules for protecting the confidentiality of documents seized during a *saisie-contrefaçon*.

**Looking Ahead:** Future case law on the articulation between the different regimes will have to be carefully monitored.

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#### New Provisions

The 11 December 2018 Decree introduces Article R. 153-1 into the French Commercial Code, authorizes the judge ordering measures of inquiry on the basis of Article 145 of the French Code of Civil Procedure, to order the provisional sequestration of the requested documents in order to protect the trade secrets they may contain. It also modifies Articles R. 521-2, R. 615-2, R. 623-51, R. 716-2, and R. 722-2 of the French Intellectual Property Code to give the same powers to the judge authorizing a *saisie-contrefaçon*.

When the judge uses these new powers, the Decree regulates the fate of the seized documents by distinguishing according to whether or not the judge receives a request for modification or withdrawal of his order.

If the judge does not receive a request to modify or withdraw his order within one month of the service of his order, the provisional sequestration measure shall be lifted and the documents shall be transmitted to the applicant.

If the judge receives a request for modification or withdrawal within the aforementioned period, he is authorized to decide on the total or partial lifting of the sequestration measure and must do so by following a procedure established by the new Article R. 153-3 of the French Commercial Code.

Under this new procedure, it is up to the party claiming trade secret protection, therefore *a priori* the party whose documents were seized, to provide the judge with:

- The complete confidential version of this document;
- A non-confidential version or a summary;
- A memorandum specifying, for each part of the document, the reasons why confidentiality must be ensured.

Given the importance of *saisie-contrefaçon* litigation, it is very likely that the courts will have to examine the relationship



between the old and new provisions.

### Coexistence with Other Previous Provisions

These new rules should coexist with previous practice and other provisions of the French Intellectual Property Code.

In particular, in the absence of a specific provision in the order authorizing the *saisie-contrefaçon* ordering the provisional sequestration pursuant to the new text, the party whose documents have been seized can still ask the bailiff to place the disputed confidential documents in a sealed envelope and not to give them to the seizing party.

And if this has not been requested during the *saisie*, a party can still ask the judge to take the necessary measures to preserve the confidentiality of the documents on the basis of Articles R. 521-5, R. 615-4, R. 623-53-1, R. 716 -5, and R. 722-5 of the French Intellectual Property Code.

Under this previously existing procedure, it is up to the seizing party to take the initiative to refer the matter to the judge (the president or the judge in charge of the management of the case) to obtain the delivery of the seized documents placed under seal, and there is no automatic end of the sequestration comparable to that provided for in the new text.

On the other hand, the procedure of release of the provisional sequestration provided for in Article R. 153-3 of the French Commercial Code should apply to all requests to unseal seized confidential documents, including those made on the basis of Articles R. 521-5, R. 615-4, R. 623 -53-1, R. 716-5, and R. 722-5 above.

Given the importance of *saisie-contrefaçon* litigation, it is very likely that the courts will have to examine the relationship between the old and new provisions.

The new provisions, however, seem to be balanced in that:

- The protection of the trade secrets of the party undergoing the *saisie-contrefaçon* is better ensured with an order already providing for the sequestration of the confidential documents;
- The referral to the judge must be made within one month of the *saisie-contrefaçon*, thus obliging the party whose documents have been seized to give a prompt opinion on its intentions and on the alleged confidentiality, which may allow for a more rapid delivery to the applicant of the confidential documents useful for providing infringement.

### TWO KEY TAKEAWAYS

1. Parties requesting for *saisie-contrefaçon* must consider whether it is appropriate to suggest the application of the new provisions concerning the provisional sequestration of the seized documents.
2. Seized parties requesting the sealing of the seized documents must follow the appropriate procedure and in particular act within one month from the *saisie-contrefaçon* in the event of application of the new provisions, to avoid the automatic release of the provisional sequestration.



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